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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/953,477	10/17/1997	SALIM G. KARA	45923-P012US	3876

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EXAMINER

POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

08/953,477

Applicant(s)

KARA ET AL.

Examiner

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 9/15/04 (being the Decision on Appeal).
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 57-74 and 90 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 57-74 and 90 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Decision on Appeal*

1. The rejection(s) of **claims 57-74, and 90**, as cited in the final Office action dated 2/12/01, have been reversed by the Board of Patent Appeals and Interferences. However, upon subsequent review and search by the examiner, the reference of Kaufeld *et al.* (U.S. Patent Number 5,859,967, which was cited previously as pertinent prior art in the Office action dated 3/19/99), can be interpreted as teaching each of the limitations found in claim 57. Therefore, prosecution is hereby reopened. A new rejection under 35 U.S.C.102(e) is set forth below regarding claims 57-74, and 90.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 57-74 and 90** are rejected under 35 U.S.C. 102(e) as being anticipated by Kaufeld *et al.* (U.S. Patent Number 5,859,967, cited as pertinent prior art in the Office action dated 3/19/99).

Regarding **claim 57**, Kaufeld discloses a system for delivering information to a selected location from a transmitting location (see abstract, Fig. 1, and column 3, lines 10-65), the system

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comprising a transmission station operable at the transmitting location (local computer 30) and adapted to transmit the information to an intermediate location (column 3, lines 10-46), and an intermediate station operable at the intermediate location (computer 26) and adapted to receive the information transmitted by the transmitting station (column 3, line 31-column 4, line 28), wherein the intermediate station (computer 26) comprises a converter circuit (microprocessor 52, seen in Fig. 2) adapted to electronically receive the transmitted information (column 3, line 31-column 4, line 16) and to convert the transmission to electronic form (interpreted as a facsimile form) if the transmitted information is not initially in electronic form (column 3, line 31-column 4, line 28), and a reproducing circuit (being either the fax board 66 or the printer 60) adapted to reproduce the information in human readable form (column 3, line 31-column 4, line 28, and column 11, lines 39-62), wherein the reproducing circuit also produces an indicia of payment authorizing delivery of the human readable information to the selected location (column 3, lines 31-46, and column 5, lines 1-57).

Regarding *claim 58*, Kaufeld discloses the system discussed above in claim 57, and further teaches of the intermediate location being selected according to proximity to the selected location (column 6, lines 24-55, whereby the address of fxsav.com, being the intermediate location, can be any suitable domain, thereby including selection according to proximity to the selected location).

Regarding *claim 59*, Kaufeld discloses the system discussed above in claim 58, and further teaches of the intermediate location selection is accomplished automatically by the transmitting location through reference to address information with respect to the selected location (column 6, lines 24-55).

Regarding *claim 60*, Kaufeld discloses the system discussed above in claim 57, and further teaches of the intermediate location is selected according to proximity to the transmitting location (column 6, lines 24-55, whereby the address of fxsav.com, being the intermediate location can be any suitable domain, thereby including selection according to proximity to the transmitting location).

Regarding *claim 61*, Kaufeld discloses the system discussed above in claim 57, and further teaches of the converter circuit comprises circuitry adapted to accept electronic documents communicated utilizing different communication protocols (column 3, line 10-column 4, line 28).

Regarding *claim 62*, Kaufeld discloses the system discussed above in claim 61, and further teaches of the different communication protocols include at least two protocols selected from the group consisting of a standardized electronic mail communication protocol (column 3, line 10-column 4, line 28), a special purpose mail communication protocol, a standardized facsimile protocol (column 3, line 10-column 4, line 28), a standardized character based protocol, and a standardized packet based protocol.

Regarding *claim 63*, Kaufeld discloses the system discussed above in claim 57, and further teaches of the converter circuit comprising circuitry adapted to determine delivery address information with respect to the selected location from information contained within the transmitted information (column 6, lines 24-55, and column 7, lines 13-34, see Figs. 4-7).

Regarding *claim 64*, Kaufeld discloses the system discussed above in claim 63, and further teaches of the converter circuit comprising circuitry adapted to verify the accuracy of the delivery address information (column 6, lines 24-55, and column 7, lines 13-34, see Figs. 4-7).

Regarding *claim 65*, Kaufeld discloses the system discussed above in claim 57, and further teaches of a means for including ancillary information with the transmitted information (column 6, lines 24-55), wherein the ancillary information being suitable for use by the receiving means in delivery of the transmitted information to the selected location (column 6, lines 24-55, and column 7, line 35-column 8, line 35).

Regarding *claim 66*, Kaufeld discloses the system discussed above in claim 65, and further teaches of the ancillary information comprising means for funding delivery of the transmitted information (column 7, line 58-column 8, line 5).

Regarding *claim 67*, Kaufeld discloses the system discussed above in claim 66, and further teaches that the intermediate station further comprises an acknowledgment circuit adapted to produce an acknowledgment of receipt of the transmitted information (see Fig. 7, column 7, lines 25-34), and wherein the acknowledgment circuitry is further adapted to transmit the acknowledgment to the transmitting location (column 7, lines 25-34, and column 8, line 57-column 9, line 21), wherein the last mentioned portion of the acknowledgment circuit is inactive until the funding means is confirmed (column 7, line 58-column 8, line 35, and column 8, line 57-column 9, line 21).

Regarding *claim 68*, Kaufeld discloses the system discussed above in claim 66, and further teaches that the funding means includes at least a value data packet (column 5, line 1-column 6, line 23).

Regarding *claim 69*, Kaufeld discloses the system discussed above in claim 68, and further teaches that the value is deducted from a credit stored at the transmitting location (column 5, lines 1-57).

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Regarding *claim 70*, Kaufeld discloses the system discussed above in claim 65, and further teaches of the ancillary information includes a delivery address of the selected location (column 6, lines 24-55, see Figs. 4-6).

Regarding *claim 71*, Kaufeld discloses the system discussed above in claim 70, and further teaches of the converter circuit comprises a means for verifying the accuracy of the delivery address information (column 6, lines 24-55, and column 7, lines 13-34, see Figs. 4-7).

Regarding *claim 72*, Kaufeld discloses the system discussed above in claim 65, and further teaches of the ancillary information includes a time of transmission of the document by the transmitting means (see Figs. 4-7), wherein the time being provided by a secure time piece disposed at the transmitting location (column 4, lines 41-46).

Regarding *claim 73*, Kaufeld discloses the system discussed above in claim 65, and further teaches of the ancillary information includes specific delivery information regarding the delivery of the human readable information (see Figs. 4-6, column 6, line 24-column 7, line 25, and column 10, line 54-column 11, line 62), indicating selection of at least one delivery option of a plurality of delivery options available for delivery of the transmitted information (column 10, line 54-column 11, line 62).

Regarding *claim 74*, Kaufeld discloses the system discussed above in claim 57, and further teaches of the reproducing circuit is operable at least in part with corresponding circuitry disposed at the selected location (column 8, line 48-column 9, line 21).

Regarding *claim 90*, Kaufeld discloses the system discussed above in claim 57, and further teaches of the intermediate station further comprising an acknowledgment circuit adapted

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to produce an acknowledgment of receipt of the transmitted information (see Fig. 7, column 7, lines 25-34, and column 8, line 57-column 9, line 21).

#### ***Citation of Pertinent Prior Art***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

**Monnot *et al.*** (U.S. Patent Number 5,432,618) discloses a facsimile certification system; and

**Bloomfield** (U.S. patent Number 5,404,231) discloses a facsimile store and forward facility.

#### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (571) 272-7410. The examiner can normally be reached on Monday-Friday, 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


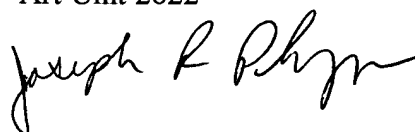


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa  
Primary Examiner  
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jrj



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